

**REMARKS**

The Examiner provides a number of rejections and we list them here in the order in which they are addressed:

- I. Claims 13, 15, and 36-37 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Essigmann et al.
  
- II. Rejections under 35 U.S.C. § 112 2
  - A. Claims 1, 13, 15-16, and 35-38 are allegedly unclear because of the term “peptide”.
  - B. Claims 1, 13, 15, 17, and 26 are allegedly unclear because of the phrase “as set forth in”.
  - C. Claims 16 and 38 are allegedly unclear because of the phrase “corresponding to”.
  - D. Claims 15-16, and 37-38 are allegedly unclear because of the phrase “such that a peptide is expressed ... isolating said expressed peptide; and reacting ... said peptide”.
  
- III. Claim Objections
  - A. Claim 1 is objected to for an alleged lack of conformity regarding “nucleic acid”.
  - B. Claims 20 and 29 are objected for an alleged unitalized E. coli.

**I. Claims 13, 15, and 36-37 Are Not *Prima Facie* Obvious Under Essigmann**

The Examiner has presented previously rebutted arguments regarding the teachings of Essigmann et al. regarding the presently claimed embodiments. Specifically, the Examiner believes that Essigmann et al. provides sufficient teachings to create a *prima facie* case of obviousness. The Applicants disagree for the reasons previously argued in past Office Action responses, including the recent Appeal Brief.

Nonetheless, without acquiescing to the Examiner's argument but to further the prosecution, and hereby expressly reserving the right to prosecute the original (or similar) claims, Applicants have canceled Claims 13, 15, 36, and 37. These cancellations are made not to acquiesce to the Examiner's argument but only to further the Applicants' business interests, better define one embodiment and expedite the prosecution of this application.

The Applicants intend to file a continuing application to further prosecute these claims and maintain the remaining claims within the present application as discussed below.

The Applicants, therefore, respectfully request that the Examiner withdraw this rejection.

## **II. The Claims Comply With 35 U.S.C. § 112 ¶ 2**

### **A. Claims 1, 13, 15-16, and 35-38 Are Not Unclear**

The Examiner asserts that the term “peptide” recited in the above claims is unclear because “SEQ ID NOs: 1, 3 and 6 encode enzymes, “polypeptides” ... not “peptides”. *Office Action* pg. 3. The Applicants disagree because the specification teaches the interchangeability of the terms “peptide” and “polypeptides”, thereby providing one skilled in the art with the proper guidance to understand the claims.

Nonetheless, without acquiescing to the Examiner's argument but to further the prosecution, and hereby expressly reserving the right to prosecute the original (or similar) claims, Applicants have amended Claims 1 and 16 to recite “polypeptide” instead of “peptide”. The Examiner is reminded that Claims 13 and 15 were canceled above for other reasons. This amendment is made not to acquiesce to the Examiner's argument but only to further the Applicants' business interests, better define one embodiment and expedite the prosecution of this application.

The Examiner is respectfully requested to withdraw the present rejection.

**B. Claims 1, 13, 15, 26 And Associated Dependent Claims Are Not Unclear**

The Examiner asserts that the phrase “as set forth in” creates a context of the claims that is not clear. The Applicants disagree because this phrase is routinely used by those having skill in the art to refer to nucleotide sequences.

Nonetheless, without acquiescing to the Examiner's argument but to further the prosecution, and hereby expressly reserving the right to prosecute the original (or similar) claims, Applicants have amended Claims 1, 17, and 26 by replacing “as set forth in” with “of”. The Applicants believe that this phrase is superfluous and that the modification does not alter the scope of these claims. The Examiner is reminded that Claims 13 and 15 were canceled above for other reasons. This amendment is made not to acquiesce to the Examiner's argument but only to further the Applicants' business interests, better define one embodiment and expedite the prosecution of this application.

The Examiner is respectfully requested to withdraw the present rejection.

**C. Claims 16 And 38 Are Not Unclear**

The Examiner asserts that the phrase “corresponding to” creates a context of the claims that is not clear. The Applicants disagree because this phrase is routinely used by those having skill in the art to refer to relationships between polypeptides and nucleotide sequences.

Nonetheless, without acquiescing to the Examiner's argument but to further the prosecution, and hereby expressly reserving the right to prosecute the original (or similar) claims, Applicants have amended Claim 16 by replacing “corresponding to” with “of the sequence”. The Applicants believe that these phrases are interchangeable and that the modification does not alter the scope of these claims. This amendment is made not to acquiesce to the Examiner's argument but only to further the Applicants' business interests, better define one embodiment and expedite the prosecution of this application.

The Examiner is respectfully requested to withdraw the present rejection.

**D. Claims 15, 16 And 37-38 Are Not Unclear**

The Examiner asserts that the phrase “such that a peptide is expressed ... isolating said expressed peptide; and reacting ... said peptide” creates a context of the claims that is not clear. Specifically, the Examiner believes that the claims, as written, read on any

peptide. The Applicants disagree because any expressed polypeptide within Claim 16 is clearly encoded by SEQ ID NO:1 or SEQ ID NO:2 as recited in subparagraph (b). The Examiner is reminded that Claim 15 was canceled above for other reasons.

Nonetheless, without acquiescing to the Examiner's argument but to further the prosecution, and hereby expressly reserving the right to prosecute the original (or similar) claims, Applicants have amended Claim 16 to recite "a polypeptide encoded by said nucleic acid sequence". The Applicants believe that this amendment merely makes explicit that which was already implicit and, consequently, does not alter the scope of the claim. This amendment is made not to acquiesce to the Examiner's argument but only to further the Applicants' business interests, better define one embodiment and expedite the prosecution of this application.

The Examiner is respectfully requested to withdraw the present rejection.

### **III. The Claims Are Not Objectionable**

#### **A. Claim 1 Is Not Objectionable**

The Examiner asserts that Claim 1 lacks uniformity because subparagraph a) iii) recites a "nucleic acid sequence" while subparagraph a) iv) recites a "nucleic acid". The Applicants disagree because one having skill in the art would understand the interchangeability of these two terms.

Nonetheless, without acquiescing to the Examiner's argument but to further the prosecution, and hereby expressly reserving the right to prosecute the original (or similar) claims, Applicants have amended Claim 1 a) iv) to recite a "nucleic acid sequence". This amendment is made not to acquiesce to the Examiner's argument but only to further the Applicants' business interests, better define one embodiment and expedite the prosecution of this application.

The Applicants respectfully request that the Examiner withdraw the present objection.

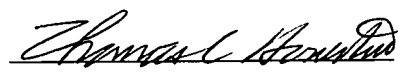
#### **B. Claims 20 And 29 Are Not Objectionable**

The Examiner asserts that Claims 20 and 29 are objectionable because a genus/species is not italicized. The Applicants have now amended Claims 20 and 29 by italicizing the genus/species in order to remove the objection.

**CONCLUSION**

The Applicants believe that the arguments and claim amendments set forth above traverse the Examiner's rejections and, therefore, request that all grounds for rejection be withdrawn for the reasons set above. Should the Examiner believe that a telephone interview would aid in the prosecution of this application, the Applicants encourage the Examiner to call the undersigned collect at 617.984.0616.

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